

REMARKS/ARGUMENTS

The claims are divided into the following Groups:

Group I: Claims 25-33, 35-39, 43 and 45, drawn to a process of producing a metal particle nucleic acid composite.

Group II: Claims 40-42, 47 and 67 drawn to a process for manufacture of a nanowire.

Applicants elect, with traverse, Group I, Claims 25-33, 35-39, 43 and 45 for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803).

The Office has characterized the inventions of Group I and II as related processes. Citing MPEP §806.05(j), the Office concludes that:

In the instant case, the inventions as claimed require different processes such that each process can be performed without the other process. Invention I is making a composite whereas invention II is making a nanowire. Invention I does not have to make a nanowire as required by Invention II, and Invention II does not have to make a composite as required by invention I. Furthermore the inventions do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

The MPEP (§806.05(j)) states that related product inventions are distinct if:

- “(A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions *as claimed* are not obvious variants; and
- (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect.”

Applicants respectfully submit that the Office has not demonstrated any of the indications of distinctness (A), (B) or (C) listed in MPEP (§806.05(j)). Moreover, Applicants specifically note that Claim 25 is directed to producing a metal particle nucleic acid composite

while Claim 40 is directed to producing a nanowire which comprises providing a metal particle nucleic acid composite. Therefore the inventions as claimed are capable of use together.

Applicants respectfully note that the claims 25-33, 35-43, 45 and 47 have been previously examined and that newly added claim 67 directly depends from the previously examined claim 40. The MPEP § 811 states:

“Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.”

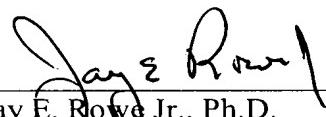
Applicants respectfully submit that since Claims 25-33, 35-43, 45 and 47 have already been searched and examined, and Claim 67 depends from Claim 40, a serious burden is not created by the new dependent claim.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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